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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/014,991	12/11/2001	Gregory E. Sancioff	ONUX-4 CON	4207

7590 04/28/2004  
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EXAMINER

JACKSON, GARY

ART UNIT PAPER NUMBER

3731

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/014,991

Applicant(s)

SANCOFF ET AL.

Examiner

Gary Jackson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 24,31 and 33-39 is/are allowed.
- 6) ☒ Claim(s) 1-19,21-23,25-30,32 and 40-52 is/are rejected.
- 7) ☒ Claim(s) 20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

GARY JACKSON  
PRIMARY EXAMINER  
GROUP 3300

*Gary Jackson*

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

This action is a response applicants' amendment and arguments filed February 17, 2004. The indicated allowability of claims 1-6 and 32 has been withdrawn after reconsideration of the art of record. The examiner regrets the delay this new rejection will cause the applicants.

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-19, 21-23, 25-30, 32 and 40-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caspari et al (US Patent 4,923,461) in view of Tiefenbrun et al (US Patent 6,331,182). The Caspari et al patent discloses a device for fixing a flexible element to a portion of tissue including structure 20 for retaining a flexible element 104 to guide said flexible element and a drive unit 68 for urging the flexible element toward the distal end. Caspari et al do not teach a securing means as recited in claim 6 for advancing the flexible element with sufficient force. However, Tiefenbrun et al discloses a securing means for variably adjusting the force to a flexible element to secure two tissue portions. Figure 6D, discloses the securing means 56. It would have been obvious to one having ordinary skill in the art to provide Caspari et al with securing means as taught by Tiefenbrun et al and a wire suture to variably adjust the securing force of the flexible element. Concerning claim 52, the Caspari et al patent discloses a support structure 20, an advancement apparatus 68, capable of penetrating tissue a severing device and receiving structure 44. Caspari do not disclose a rotation apparatus; however, please see reference to the Tiefenbrun et al patent above.

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Concerning claim 32, it is well settled that it is not "invention" to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result. In re Rundell, 18 CCPA 1290, 48 F.2d 958, 9 USPQ 220.

***Allowable Subject Matter***

Claims 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 24, 31, 32-39 are allowable over the art of record.

***Response to Arguments***

Applicant's arguments filed February 17, 2004 have been fully considered but they are not persuasive. The phrase "while said hollow wire guide remains outside of the at least two portions of the subject" has been considered but it does not distinguish the claims over the references. This phrase does not limit the structure of the claimed device and further, the Caspari et al reference is capable of being used without penetrating tissue. The ability to penetrate tissue is also a function of the wire stiffness and insertion device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Jackson whose telephone number is (703) 308-4302. The examiner can normally be reached on Mon.-Thurs. 7:30 am to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Milano can be reached on (703) 308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gary Jackson  
Primary Examiner  
Art Unit 3731



gj  
April 19, 2004,